

REMARKS

The Office Action dated November 3, 2005, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claim 3 has been canceled and claims 1, 6 and 9 have been amended. Support for the amendments to claim 1 can be found in at least paragraph [0023] of the Specification as originally filed. No new matter has been added. Claims 1, 2, 5, 6, 8, 9, 11-13 and 15-19 are pending and respectfully submitted for consideration.

Interview

The Applicants wish to thank the Examiner for the interview granted on February 7, 2006. In the interview, claim 1 and the Saito et al. reference (Japanese Patent Publication No. 10001166, "Saito") were discussed. In the interview, the proposed amendments to claim 1 were discussed as well as how the proposed amendments would overcome the 35 U.S.C. § 112, first paragraph, rejections in combination with the Japanese industrial standard test provided to the Examiner. In the interview, the Applicants' representative also presented how the Saito reference does not disclose the claimed soft wood kraft pulp content recited in claim 1.

In the interview the Examiner requested clarification on the claimed aspect ratio of tensile strength. The Applicants further submit that the aspect ratio recited in claim 1 is the ratio of the tensile strength for the longitudinal direction to the tensile strength for the cross direction. See, for example, paragraph [0075] of the Specification of the

present application where the tensile strength 8.6 kg/15 mm for longitudinal direction divided by tensile strength of 1.6 kg/15 mm for the cross direction yields a value of 5.4 for the aspect ratio. See also paragraphs [0082], [0088], [0095] and [0099]. As a result of the discussions in the interview regarding the proposed claim amendments, the Examiner indicated that a further search would be conducted.

Claim Objection

Claim 1 was objected to for a minor informality. Responsive to the objection, the Applicants have amended claim 1 as set forth above.

Rejections Under 35 U.S.C. § 112

Claims 1-3, 5, 6, 8, 9, 11-13 and 15-19 were rejected under 35 U.S.C. § 112, first paragraph. Claims 1-3, 5, 6, 8, 9, 11-13 and 15-19 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 3 has been canceled, rendering the rejection moots with regard to this claim. The Applicants have amended the claims responsive to the rejection and as discussed with the Examiner in the interview. The Applicants also submitted a copy of the Japanese Industrial Standards P8113 to the Examiner for consideration.

In view of the claim rejections under 35 U.S.C. § 112, first and second paragraphs, and the claim objections, the Applicants respectfully submit that amended claim 1 overcomes the noted objections and rejections. The Applicants further appreciate the Examiner's acknowledgement during the interview that the proposed amendments to claim 1 overcome the noted objections and rejections. As such, the Applicants respectfully submit that all claims are in compliance with U.S. patent practice.

Rejection Under 35 U.S.C. § 102

Claims 1-3, 5, 6, 8, 9, 11 and 16-19 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Saito et al. (Japanese Patent Publication No. 10001166, "Saito"). Claim 3 has been canceled, rendering the rejection moot with regard to this claim. Claims 2, 5, 6, 8, 9, 11 and 16-19 depend from claim 1.

Saito discloses that 30 parts NUKP [unbleached kraft pulp], 30 parts LUKP [unbleached kraft pulp] and 60 parts color high-quality old paper 6 as raw materials of a buffer material were mixed and prepared at the degree of beating of 30° SR, so that a raw paper with Tsubo of 37 g/m² was made as a circular netted paper.

With respect to claim 1, the Applicants respectfully submit that Saito fails to disclose or suggest the claimed features of the invention. Amended claim 1 recites that the aspect ratio of tensile strength of the base paper is in a range from 5 to 15 as measured by Japanese Industrial Standard P 8113. Saito does not disclose a tensile strength of the base paper in a range of from 5 to 15 as measured by the Japanese Industrial Standard P 8113. The Office Action has acknowledged that Saito does not teach the aspect ratio of tensile strength of the base paper as recited in claim 1. See page 6, line 12 of the Office Action. As discussed above, the Applicants have amended claim 1 to overcome the rejections under 35 U.S.C. § 112, first and second paragraphs, and respectfully submit that the claim limitation of the aspect ratio is definite and not disclosed in Saito.

Rejection Under 35 U.S.C. § 103

Claims 12, 13 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito as applied to claims 8, 9 and 11 above, and further in view of Phan et al. (U.S. Patent No. 6,136,146, "Phan") or Kearney et al. (U.S. Patent No. 4,225,382, "Kearney"). Saito was cited for teaching many of the claimed elements of the invention with the exception of the specific wet strength-enhancing agent. Phan and Kearney were cited for curing this deficiency.

Phan discloses a non-through air dried paper web and method of making such a paper web. The paper web includes at least two regions of different density and at least two regions of different basis weight. See the Abstract of Phan.

Kearney discloses an improved process to produce a tissue which becomes ply-separable during the papermaking process. A first furnish, to be laid adjacent the forming wire, was comprised of 100 percent kraft eucalyptus pulp. The fiber was combined with 4.7 pounds of a 2 percent solution (by weight) of PAREZ 631NC wet strength resin per ton of fiber, and was unrefined. (PAREZ 631NC is a modified polyacrylamide wet strength resin available from the American Cyanamid Company.) The basis weight of the first furnish was 10.8 pounds per 3,000 sq. ft., and it was supplied to the headbox at a flow rate of 111 gallons per minute and at a consistency at the headbox of 0.26 percent fiber by weight.

With respect to claims 12, 13 and 15, the Applicants respectfully submit that the combination of Saito and Phan or Saito and Kearney fails to disclose or suggest the claimed features of the invention as both Phan and Kearney fail to cure the deficiencies in Saito with respect to claim 1, from which claims 12, 13 and 15 depend. Specifically,

neither Kearney nor Phan disclose or suggest the aspect ratio of tensile strength of the base paper is in a range from 5 to 15 as measured by Japanese Industrial Standard P 8113.

Further, none of Saito, Phan or Kearney disclose or suggest that the base paper is made by a cylinder paper machine. As such, Phan and Kearney fail to cure the deficiencies in Saito with respect to claim 1, and therefore, claims 12, 13 and 15.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

In view of the above, the Applicants respectfully submit that Saito, Phan and Kearney, either singly or in combination, fail to disclose or suggest the combination of features recited in the claims. Therefore, Saito, Phan and Kearney do not support a *prima facie* case of obviousness for purposes of a rejection of claims 12, 13 and 15 under 35 U.S.C. §103.

Conclusion

Claims 2, 5, 6, 8, 9, 11-13 and 15-19 depend from claim 1. The Applicants respectfully submit that each of these claims incorporate the patentable aspects thereof, and are therefore allowable for at least the same reasons as discussed above. Accordingly, the Applicants respectfully request withdrawal of the objections and rejections, allowance of claims 1, 2, 5, 6, 8, 9, 11-13 and 15-19 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 108421-00080.**

Respectfully submitted,



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Enclosure: Petition for Extension of Time (one-month)

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